

### REMARKS

This amendment is accompanied by a Request for Continued Examination (RCE) and RCE fee.

Claims 1, 3, 4, 6-10, 12-14, 17-20, 22-24 and 27-49 are pending in the above application. Claims 1, 4, 29, 31 and 47 are independent. In the Office Action of June 2, 2004, claims 1, 3, 4, 6-10, 12, 14, 17-20, 22, 24, 27-37, 39-44 and 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,096,037 to Mulier et al. (Mulier '037). Claims 1, 4, 13, 23, 29, 31, 38 and 45 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,273,887 to Yamauchi et al. (Yamauchi '887). Claims 1-26 were further rejected under the judicially created doctrine of obviousness type double patenting over U.S. Patent 6,517,536 in view of Mulier '037.

Amended independent claim 1 is generally directed to a device for clamping and ablating cardiac tissue. The device comprises first and second handle members, first and second jaw members and first and second elongated electrically conductive members. The jaw members each have an opposed clamping surface having a width. The first and second conductive members each have a tissue contacting portion having a width which is less than or equal to about 1/3 the width of its associated clamping surface of the jaw. The first and second conductive members are adapted to be connected to an RF energy source to conduct electrical current through tissue which is clamped between the jaw members. The

electrical current for ablation is conducted solely by the electrically conductive members.

Independent claim 4 is generally directed to a tissue grasping apparatus having first and second grasping jaws. Each jaw has a width and includes an elongated electrically conductive member and a clamping surface in face to face relationship with the electrically conductive member and clamping surface of the other jaw. The face to face electrically conductive members are connectable to an RF energy power source for providing an electrical current through tissue which is clamped between the jaws and electrical current for ablation is conducted solely by the electrically conductive members. The electrically conductive members have a tissue contacting portion having a width which is less than or equal to about  $1/3$  the width of its associated jaw.

Independent claims 29 and 31 include similar subject matter of claims 1 and 4, respectively, except these claims recite that the width of tissue contacting portion is less than the width of its associated clamping surface. Claims 29 and 31 further include the feature that the tissue contacting portion of the electrically conductive members is disposed with a portion of the respective clamping surface on each side of the respective conductive member.

Independent claim 47 is generally directed to a tissue grasping apparatus having first and second grasping jaws which include first and second electrically conductive members,

respectively, the electrically conductive members are in a face to face relation with each other and are connectable to an RF energy power source for providing electrical current through the tissue clamp between the jaws. The electrical current for ablation is conducted solely by the electrically conductive members. At least one of the electrically conductive members defines an interior lumen.

It is respectfully submitted that the currently pending claims in this application should be allowed over Mulier '037 and Yamauchi '887 because these references do not teach or support the claimed reference.

In the Office Action, Mulier '037 is relied upon to teach an elongated electrically conductive member carried by each jaw, as recited in claim 1. It is respectfully believed that this is an oversimplification. Mulier '037 discloses a very different jaw structure for each jaw. Each jaw 40, 140, 240 is supplied by an electrolytic solution to coagulate tissue positioned between the jaws 38 and 40. The electrolytic solution is a liquid, such as saline, which exits spaced openings 166 along a conduit. This liquid does not define any structure which is carried by the jaws. Rather, the electrolytic solution is conveyed through the jaw structure and expelled from the jaw.

Further, the electrolytic solution also fails to teach or suggest other features of claim 1. The electrical current in Mulier '037 is not conducted solely by the electrically conductive

members. In Mulier '037, the electrical current is essentially conducted by the electrolytic solution which passes through the jaw rather than conducted by any structure which is carried by the jaw. For these reasons, Mulier '037 fails to teach or suggest the subject matter of claim 1.

For these reasons, amended claim 1 and its dependent claims are believed to be distinguishable over the cited reference to Mulier '037. Amended independent claims 4, 29, 31 and 47 were also rejected on the basis of the Mulier '037 reference. Each of these claims and their respective dependent claims also should be distinguishable over Mulier '037 for the same reasons as recited above with respect to claim 1.

Independent claims 1, 4, 29 and 31 were further rejected on the basis of the Yamauchi '887 reference. Claim 1 is also respectfully believed to be distinguishable over the cited reference to Yamauchi '887.

In the Office Action, Figures 74A and 74B of Yamauchi '887 are specifically relied upon as the basis for rejection of the claims. In Figures 74A and 74B, incision projections 549a and 549b are projecting portions of the jaws 548a and 548b, respectively. These jaws 548a and 548b do not teach or suggest the features of claims 1 and 4. The incision projections 549a and 549b extend perpendicularly from each opposing surface of the associated jaw and are capable for cutting tissue. Indeed, the incision projections 549a and 549b comprise their own facing

surfaces 551 for cutting tissue. Yamauchi '887 discloses that the surfaces 551 of the incision projections 549a and 549b are the only surfaces of each jaw which engage tissue, as shown in Figures 74A and 74B. No other portion of the jaws, e.g., the insulating layers 552, comprises a clamping surface of the jaws 548a and 548b for clamping of tissue. Any clamping surface is comprised entirely of the electrically conductive projections 548a and 548b, in contrast to claims 1 and 4. Moreover, it would not be obvious to modify Yamauchi. Yamauchi teaches that the surfaces 551 of the incision projections 549a and 549b must also be disposed to cut tissue so that these surfaces 551 must not be combined as part of the width of any other clamping surface. For this reason, claims 1 and 4 should be allowable over Yamauchi '887.

Independent claims 29 and 31 recite all the features of claims 1 and 4, respectively, and, as such, should be allowable over Yamauchi '887 for the same reasons as stated above. Each of the remaining claims 3, 6-10, 12-14, 17-20, 22-24, 27-28, 30 and 32-49 is dependent either directly or indirectly from one of claims 1, 4, 29, 31 and 47, and is thus also believed to be allowable.

Turning to the rejection for double patenting over U.S. Patent 6,517,536 in view of Mulier '037, applicants respectfully request reconsideration because it is believed that the grounds for rejection do not represent an instance where a double

patenting issue can be raised. According to MPEP Section 804 I.A., an instance of double patenting may exist between an issued patent and an application filed by the same inventive entity. However, the MPEP does not describe an instance of double patenting where the grounds for rejection are based on an issued patent filed by the same inventive entity in combination with another patent not owned by the same inventive entity which is the instance described in the Office Action. The Office Action includes a double patenting rejection which is based on an issued patent owned by the same inventor and assignee of the present invention (Michael D. Hooven and AtriCure, Inc., respectively) in combination with Mulier '037, a patent owned by a different inventor and assignee, (Peter M. J. Mulier, Michael F. Hoy and Medtronic, Inc., respectively). Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

Turning to the rejection under 35 U.S.C. 112, second paragraph, the claims have been amended, where necessary to correct instances of indefiniteness. It is respectfully believed that these amendments fully address the rejection and that no further corrections are necessary.



INFORMATION DISCLOSURE STATEMENTS

Applicant also respects that the references cited in applicant's information disclosure statements mailed April 1, 2004 and June 15, 2004, be considered and made of record in this application and initialed copies of the listing of references be returned to the applicant. For the Examiner's convenience, applicants have enclosed copies of each PTO/SB/08A Form which has been previously mailed to the USPTO in the event such forms have not yet reached the Examiner. Copies of these listed documents have been previously mailed to the USPTO. However, additional copies of such documents can be mailed upon Examiner's request.

Respectfully submitted,

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